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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,670	03/08/2001	Masuo Aizawa	Q63394	4840

7590 12/04/2003

Sughrue Mion Zinn Macpeak & Seas PLLC
2100 Pennsylvania Avenue NW
Washington, DC 20037-3213

EXAMINER

CEPERLEY, MARY

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 12/04/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,670

Applicant(s)

AIZAWA ET AL.

Examiner

Mary (Molly) E. Ceperley

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8 and 9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

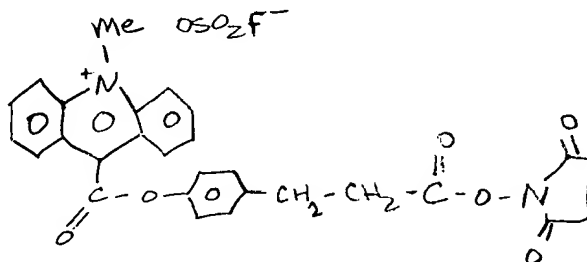
- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/232,256.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 11.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1641

Before I act on this application, I was wondering if you would clarify the following problem for me. I believe that the compound used in new claims 8 and 9 has the following formula:



This compound corresponds to formula (2) of claim 1 wherein R_{11} = methyl; R_{12} - R_{15} , R_{17} , R_{18} = H; R_{16} = - R_{19} - R_{10} wherein R_{19} = ethyl; R_{10} is as depicted at col. 11, lines 40-45 (i.e. succinimidyloxycarbonyl); X_1 = OSO_2F . $\{R_{16} = "4-[2-(succinimidyloxycarbonyl)ethyl]" ; R_{11} = "10-methyl" \}$.

If this is in fact the case, then original claims 4 and 7 would appear to be correctly dependent from claims 1 and 5 and the reissue oath would be improper since it is not the case that "the specific ester of dependent claims 4 and 7, dependent on independent claims 1 and 5, respectively, does not fall within the scope of general formula (2) of the independent claims".

****Note that the spelling of "succinim~~z~~ylxycarbonyl" of line 3 of claim 8 and line 8 of claim 9 should be --succinimidyloxycarbonyl--.**

Thank you for any input you might have.

MEC

Mary E. (Molly) Ceperley

Primary Examiner AU 1641

Art Unit: 1641

1) The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The reissue declaration fails to state that the persons signing have reviewed and understand the claims as amended by any amendment specifically referred to in the declaration. See 37 CFR 1.63(b)(1). A supplemental reissue declaration to correct this defect is required (see MPEP 1414.01).

2) The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

3) The claims are allowable over the prior art of record for the reason that the prior art does not teach nor fairly suggest the claimed chemiluminescence-based detection methods which use either an acridinium ester as defined in claim 1 or an acridinium ester as defined in claims 8 and 9 as a detectable moiety in an assay which involves reacting at a pH of 6 to 10 the acridinium ester and a superoxide ion produced in situ by electrochemical reduction of oxygen dissolved in a electrolyte using electrodes in the presence of a flavin compound.

4) In each of claim 8, line 3 and claim 9, line 8, the spelling of the term "succinimidylloxycarbonyl" should be corrected.

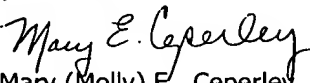
5) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (703) 308-4239. The examiner can normally be reached from 8 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556 or (703) 305-3592.

Art Unit: 1641

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

October 23, 2003


Mary (Molly) E. Ceperley
Primary Examiner
Art Unit 1641



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Fax Cover Sheet

Date: 02 Sep 2003

To: Lee C. Wright	From: Mary (Molly) E. Ceperley
Application/Control Number: 09/800,670	Art Unit: 1641
Fax No.: 202-293-7860	Phone No.: (703) 308-4239
Voice No.:	Return Fax No.: (703) 305-7230
Re: Reissue 09/800,670	CC:
<input checked="" type="checkbox"/> Urgent <input type="checkbox"/> For Review <input type="checkbox"/> For Comment <input checked="" type="checkbox"/> For Reply <input type="checkbox"/> Per Your Request	

Comments:

I sent the attached FAX to you on Jan. 21, 2003. I don't have any record of having received a response from you. In order to expedite prosecution, would you please consider/reconsider the problem described in the attached letter and give me the benefit of your appraisal of the claims. I apologize if I have misplaced your original response to this request.

Thank you.

Number of pages 4 including this page

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Fax Cover Sheet

Date: 21 Jan 2003

To: Lee C. Wright	From: Mary (Molly) E. Ceperley
Application/Control Number: 09/800,670	Art Unit: 1641
Fax No.: 202-293-7860	Phone No.: (703) 308-4239
Voice No.: 202-293-7060	Return Fax No.: (703) 305-7230
Re: 09/800,670	CC:

☐ Urgent ☒ For Review ☐ For Comment ☒ For Reply ☐ Per Your Request

Comments:

Please see the attached letter.

Number of pages 2 including this page

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